

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Hiroaki NEMOTO et al. Confirmation No.: 3964
Serial No.: 10/069,732 Art Unit: 2627
Filing Date: February 26, 2002
For: MAGNETO-OPTICAL RECORDING DEVICE CAPABLE OF
CHANGING THE SHAPES OF HEATING AREAS
U.S. Patent No.: 7,688,685
Issue Date: March 30, 2010

RENEWED PETITION UNDER 37 CFR 1.181 and
REQUEST FOR REVIEW OF DENIAL OF PETITION TO CORRECT FILING
DATE UNDER 37 CFR 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 24, 2011

Sir:

Patentee hereby petitions the Director under 37 CFR 1.181 for review of the Decision on Petition mailed January 24, 2011 which was dismissed. The Petition requested that the 371(c)(1), (c)(2), c(4) date indicated on the face of the patent, U.S. Patent No. 7,688,685, be changed to February 28, 2002 in view of a data entry error made in the Patent Office records during the prosecution of the application.

Statement of Facts

The Petition is based on the following facts:

(1) Patentee entered the national phase of a PCT international application filed on February 28, 2002 as U.S. Application No. 10/069,732, now U.S. Patent No. 7,688,685. However, the USPTO records reflect a date on which the international application fulfilled the requirements of 35 U.S.C. § 371 of February 26, 2002 for U.S. Application No. 10/069,732.

(2) On February 28, 2000, Patentee met the requirements of 35 U.S.C. 371 for the US national stage filing of PCT International Application No. PCT/JP00/01200, filed March 1, 2000.

(3) Patentee received a stamped PTO receipt post card for U.S. Serial No. 10/069,732, now U.S. Patent No. 7,688,685 dated February 28, 2002. See Attached page serving as Exhibit 1.

(4) Additionally, Patentee notes that a page filed in the application entitled "List of Inventor's Names and Address", is stamped received by the PCT/PTO February 28, 2002. See Attached page serving as Exhibit 2.

(5) A Notice of Acceptance of Application Under 35 U.S.C. 371 was mailed May 5, 2002 which erroneously reflects the February 26, 2002 date of receipt of 35 U.S.C 371(c)(1), (c)(2) and c(4) requirements.

(6) After examination of U.S. Application No. 10/069,732, Applicant's received a Notice of Allowance, and subsequently paid the issue fee and U.S. Patent No. 7,688,685 issued on March 30, 2010.

(7) There was no publication of the application in the United States.

The Patent and Trademark Office began publishing, for the first time, patent applications filed on or after November 29, 2000.

(8) Shortly after the patent issued, the Patentee noticed that the Sect. 371 date was in error and instructed the undersigned attorney to file a Request for Certificate of Correction to change the Sect. 371 date to February 28, 2002. The Request for Certificate of Correction was filed April 21, 2010 and issued on June 8, 2010. See Attached page serving as Exhibit 3.

(9) Following an attempt to correctly state the filing date of the present application for the record in a continuation application (U.S. application No. 12/710,738 filed February 23, 2010), the Patent Office advised that the 371 date of February 26, 2002 will not be changed until a Petition has been granted. See Notice mailed July 22, 2010 in the said continuation application.

(10) Accordingly, Applicant filed the Petition on October 8, 2010. On January 24, 2011, the Petition was dismissed and the Certificate of Correction dated June 8, 2010 was vacated.

(11) PCT International Application No. PCT/JP00/01200, filed March 1, 2000, by virtue of its international filing date, which is before November 29, 2000, did not establish the US application which matured into the present patent or the publication of the International Application with a reference date, to be used in examination of other applications under 35 U.S.C. § 102(e), until the US patent issued. See MPEP 706.02(a)¹.

¹ No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e) in accordance with the last

Points to be Reviewed

- (1) The determination that the Petition was not timely filed based on that part of the Decision on Petition which states:

A review of Office records reveals that the application was prosecuted using February 26, 2002 as the filing date. As such, the Applicant was aware of and accepted the filing date of the application, now U.S. Patent No. 7,688,685, as February 26, 2002. Moreover, the patent issued more than six months before the filing of the present petition, and the public has a right to rely upon the filing date of the application as shown in Office records since February 26, 2002.

In particular, the public would not be expected to rely upon the Sect. 371 date of the patent until the patent issued because the International Application was filed before November 29, 2000, which was not taken into consideration in dismissing the Petition.

sentence of the effective date provisions of Pub. L. 107-273. **Patents** issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. **Publications** of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the national stage (35 U.S.C. 371)) do not have a 35 U.S.C. 102(e) date at all (however, such publications are available as prior art under 35 U.S.C. 102(a) or (b) as of the publication date). Specifically, under revised 35 U.S.C. 374, the international application must be filed on or after November 29, 2000 for its WIPO publication to be "deemed a publication under section 122(b)" and thus available as a possible prior art reference under 35 U.S.C. 102(e) as amended by the AIPA. [Emphasis in original]

(2) The determination that the Petition was not timely filed based on that part of the Decision on Petition which states:

In view of the foregoing, and no objection having been received within two months of the date of the patent having issued with the filing date of February 26, 2002, the present petition requesting a change in Office records to reflect the filing date of the present patent to February 28, 2002, is dismissed as untimely.

(3) The determination in the Decision on Petition which states that the Certificate of Correction is to be VACATED.

Discussion

As to Point (1) to be reviewed, the Patentee did not realize the error in the Patent Office records until the patent issued and then promptly took an appropriate action to correct the error. The public was promptly notified of the error in the Patent Office records as a result of the filing of the Request for Certificate of Correction. The public would not be expected to rely upon the Sect. 371 date of the patent until the patent issued because the International Application was filed before November 29, 2000. The reasoning is explained in detail herein below.

As to Point (2) to be reviewed, an objection to the filing date was made by the patentee and received by the PTO on April 21, 2010, which is within two months of the date of the issuance of the patent of March 30, 2010. The Certificate of Correction was then issued on June 8, 2010 without objection from the Patent Office.

The reasoning upon which the Decision on Petition is based mentions reliance of the public on the incorrect Sect. 371 date, and lack of timeliness to correct the date. However this reasoning doesn't take into account that the patent issued from an International Application filed before November 29, 2000. There was little opportunity for any member of the public to rely on the error in the date sought to be corrected by Petition since the date had no effect until the patent issued. In particular, the public would not be expected to rely upon the Sect. 371 date of the patent until the patent issued because the International Application was filed before November 29, 2000 and therefore there was no publication of the application in the US and no use permitted of the international filing date under 35 USC §102(e) for the published international application. See footnote 1.

It is noted that 35 U.S.C. § 363 states that "[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office" and PCT Article 11 (referenced in 35 U.S.C. § 363) states "an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State" except as identified in Article 64(4). Article 64(4) relates to the prior art date of a reference (e.g. the 35 U.S.C. § 102(e) date).

Accordingly, the Sect. 371 date for the patent under consideration had no effect under the applicable statutes, except for under 35 USC §102(e), which effect was not realized until the patent issued.

That is, with respect to the prior art date of a reference (e.g. the 35 U.S.C. § 102(e) date), under MPEP §2136.03(II)(C), Examiners are advised that an International application does not have a 35 USC §102(e) date if the International application is filed before November 29, 2000. Again, the filing date of the international application from which the present patent issued is March 30, 2000. Accordingly, the date of receipt of the requirements under 35 USC §371(c), which is erroneously indicated as February 26, 2002 did not have any effect under 35 USC §102(e), until the patent issued on March 30, 2010.

Additionally, although the Decision on Petition vacated the issued Certificate of Correction, the public has notice that there is an error in the Sect. 371 date. Accordingly, the only reliance the public had on the erroneous date of February 26, 2002 was from the period of issuance of the patent on March 30, 2010 until April 21, 2010 since the Sect. 371 date would not have been used by an Examiner before the issuance of the patent as a reference date under 35 USC §102(e). Accordingly, Patentee has shown that the Sect. 371 date was corrected in a timely manner by Certificate of Correction and the Patentee relied upon the granting of the Certificate of Correction by the Patent Office in a belief that the error had been corrected.

It was not until Patentee attempted to correct the Continuing Data in continuation application No. 12/710,738 that the Patent Office first advised the

Patentee to correct the 371 date in the '732 application by Petition, in order to have the priority data correctly entered into the Patent Office system for the continuation application.

Request For Action

Patentee requests that the 371(c)(1), (c)(2), c(4) date indicated on the face of the patent and in the Patent Office record, e.g., the PAIR record and associated PALM or the equivalent record, be changed to February 28, 2002 in the above identified patent.

Patentee requests that the Certificate of Correction dated June 8, 2010 be reinstated or otherwise not vacated.

Conclusion

Patentee is electronically filing this Petition with the appropriate fee and requests that the foregoing action be taken on their behalf.

Should any additional fees become due in connection with the filing of this response, please charge Deposit Account No. 50-1417 (Case No. ASA-1074).

Respectfully submitted,

MATTINGLY & MALUR, P.C

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Date: March 24, 2011

ASA-1074

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In re Patent Application of

H. NEMOTO et al

Serial No.

Filed: February 28, 2002

For: METHOD AND DEVICE FOR INFORMATION RECORDING/
REPRODUCING AND INFORMATION RECORDING MEDIUM

Papers Filed Herewith:

1. Title Page; Specification (42 pp.), 10 Claims, Abstract;
2. Declaration and Power of Attorney;
3. Check #5693 for \$974.00 (Filing Fee);
4. 12 sheets soft formal drawings (Figs. 1-19);
5. Preliminary Amendment;
6. List of Inventors' Names and Addresses;
7. PTO-1390 Transmittal; and
8. Serial No. postcard.

Receipt is hereby acknowledged of the papers filed, as identified in connection with the above-identified patent application.

COMMISSIONER OF PATENTS AND TRADEMARKS



10/069732

JC13 Rec'd PCT/PTO 28 FEB 2002

ASA-1074
W0217-01

LIST OF INVENTORS' NAMES AND ADDRESSES

Hiroaki NEMOTO, Kokubunji, JAPAN;

Hideki SAGA, Fuchu, JAPAN;

Hirofumi SUKEDA, Tokorozawa, JAPAN.

EXHIBIT 2

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,688,685 B1
APPLICATION NO. : 10/069732
DATED : March 30, 2010
INVENTOR(S) : H. Nemoto et al.

Page 1 of 1

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

ON THE TITLE PAGE

Please correct (86) PCT No.: to read as follows:

(86) PCT No.: PCT/JP00/01200

§371(c)(1),
(2), (4) Date: Feb. 2628, 2002



Signed and Sealed this

Eighth Day of June, 2010

David J. Kappos

David J. Kappos
Director of the United States Patent and Trademark Office